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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,410

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Scott Costa

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EXAMINER

BATES, ZAKIYA W

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,410	Applicant(s) COSTA ET AL.	
	Examiner /Zakiya W. Bates/	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 and 145-147 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 and 145-147 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The previously indicated allowable subject matter has been withdrawn due to further consideration.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 16-18, 28-33, 35, 36, 38, 42-46, 49-53, 58, 59, and 145-147 are rejected under 35 U.S.C. 102(e) as being anticipated by Lohbeck (US 6,273,634).

Regarding claim 1, Lohbeck discloses a method, comprising: slidably coupling an end of a first tubular member 8 to an end of a tubular sleeve 6; slidably coupling an end of a second tubular member 9 to another end of the tubular sleeve; threadably coupling the ends of the first and second tubular members to the sleeve with screws 11 (Figs. 2); and radially expanding and plastically deforming the first tubular member and the second tubular member (claim 10).

With respect to depending claims, the screws 11 thus latch the ends of the first and second tubulars to the sleeve. The two tubulars and sleeve are radially expanded and plastically deformed into engagement with a wellbore or wellbore casing, the

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expansion provided by an expansion mandrel, or cone that applies radial pressure to the interior surface (col. 1, lines 5-17). The sleeve is metallic based on the cross hatching of the drawing, wherein it is notoriously known that the sleeve can be broken if too much force is used on the screws, or if too much compression or tension is placed between the sleeve and the tubulars. A fluid tight seal is provided by the flush-type connection between the two tubulars and the sleeve before, during, and after expansion (col. 2, lines 23-35). during expansion, the sleeve will be in circumferential tension and the ends of the two tubulars will be in circumferential compression due to the expansion mandrel exerting radial pressure to the interior of the sleeve and tubulars; whereas, after expansion, the sleeve will be in circumferential compression and the ends of the two tubulars will be in circumferential tension due to the forces between the wall of the wellbore and the exterior of the sleeve and tubulars.

Regarding the method claims, Lohbeck discloses a method of radially expanding and plastically deforming a first tubular member 8/18 and a second tubular member 9/19, comprising: coupling an end of the first tubular member with an end of a tubular sleeve 6/16; coupling an end of the second tubular member with another end of the tubular sleeve (Figs. 2 and 3); placing the tubular members within a wellbore; and displacing an expansion device through the interiors of the first and second tubular members to radially expand and plastically deform portions of the first and second tubular members (claim 10). The ends of the first and second tubular members are received within the ends of the tubular sleeve (Fig. 2). The ends of the first and second tubular members receive the ends of the tubular sleeve (Fig. 3). A fluid tight seal is provided by the flush-

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type connection between the two tubulars and the sleeve before, during, and after expansion (col. 2, lines 23-35).

3. Claims 1-9, 16-18, 28-36, 39, 40, 49-63, 145-147 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,564,875 of Bullock.

Bullock discloses an apparatus, comprising: a tubular sleeve 120; a first tubular member 110 coupled to an end of the tubular sleeve, the first tubular comprising internal threads 105 at an end portion; and a second tubular member 115 coupled to another end of the tubular sleeve, the second tubular comprising external threads at an end portion that engage the internal threads of the end portion of the first tubular member (Fig. 1). The tubular sleeve is in circumferential tension because the tightening of the threads will cause the first tubular member to press outwardly against the sleeve to a certain extent; the end portion of the first tubular member is in circumferential compression and the end portion of the second tubular member is in circumferential compression due to the engagement of the threads between the two tubulars. The tubular sleeve comprises an internal flange 132 and external flange 127 (Fig.1). The end portion of the first tubular member at 135 is received within the end of the tubular sleeve; and wherein the end portion 130 of the second tubular member is received within the other end of the tubular sleeve. The end portion of the first tubular member at 135 is received within an end of the tubular sleeve so that the end portions of the first and second tubular members abut the internal flange of the tubular sleeve, the end of the second tubular being 127. The internal flange of the tubular sleeve is positioned at an end of the tubular sleeve (Fig. 1). The sleeve is preferably made of plastic, which can

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be frangible (col. 2, lines 47-50). The threads of the two tubulars provide a fluid tight seal at least due to the o-ring between the two sets of threads (o-ring is unlabeled, but seen near the top of the figure).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103 (a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 10-15, 19-24, 37, 38, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullock alone.

Regarding claims 38 and 41, Bullock teaches that the sleeve can be made of commercially available materials (col. 2, lines 45-47). At the time of the invention, it would have been obvious to one of ordinary skill in the art that the sleeve could be made of metal as it is notoriously known that metal is a commercially available material. Regarding claims 10-15, 19-24, 37, Bullock teaches an apparatus with the limitations as

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above, but it does not necessarily teach that the tubular sleeve has a resilient retaining ring. Nevertheless, it can be seen near the top of the figure that an o-ring is between the two tubular members; therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to try placing a sealing member, such as the o-ring, between the sleeve and at least one of the tubulars, or on the exterior of the sleeve, because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.

6. Claims 25-27, 47, 48 are rejected under 35 U.S.C. 103(a) as being obvious over Bullock in view of US 6,557,640 of Cook et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing

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that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(1) (1) and § 706.02(1) (2).

Bullock does not specifically teach that the first and second tubular members are amorphously bonded or welded together.

Cook et al teach that threaded connections, such as that of Bullock, are part of a list of commercially available mechanical couplings, wherein amorphously bonding and welding are also other types of commercially available mechanical couplings (col. 58, line 65 through col. 59, line 3). Thus, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use either amorphous bonding or welding in place of threads as the substitution of one known element for another would have yielded predictable results to one of ordinary skill.

12. Claims 25-27, 47, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lohbeck in view of Cook et al.

Lohbeck does not specifically teach that the first and second tubular members are amorphously bonded or welded together.

Cook et al teach that threaded connections, such as that of Lohbeck, are part of a list of commercially available mechanical couplings, wherein amorphously bonding and welding are also other types of commercially available mechanical couplings, which involve heating of at least the ends of the tubulars (col. 58, line 65 through col. 59, line 3). Thus, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use either amorphous bonding or welding in place of threads as the substitution of one known element for another would have yielded predictable results to

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one of ordinary skill.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. The pending Claims of the instant invention are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 10/510966. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are merely a broadened form of the ‘966 application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 6/9/09 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Zakiya W. Bates/ whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on (571) 272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Zakiya W. Bates/
Primary Examiner
Art Unit 3676

zb
9/11/09